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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,053	07/03/2003	Jan Van Dijk	055506-0112	4868
	7590 10/29/2003		EXAMINER	
Foley & Lardner Suite 500 3000 K Street, N.W. Washington, DC 20007-5109			BELL, KENT L	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,053	Applicant(s) DIJK, JAN VAN	
	Examiner Kent L. Bell	Art Unit 1661	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to application filed 7/3/03 communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/3/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input checked="" type="checkbox"/> Other: <u>Rule 1.105 Requirement</u> |

**Detailed Action**

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

### **Detailed Action**

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 20, In addition to applicant stating the instant plant's characteristics are firmly fixed and retained through successive generations of asexual reproduction, applicant should state the instant plant reproduces true to type through successive generations of asexual reproduction.

B. Page 2, line 6, Applicant states "peduncle". Rather than stating "peduncle" applicant should state --scape-- as this is the more appropriate term to use in this instance.

C. Page 2, lines 6, 8, 11-13, 17, and 18, page 3, lines 1-5, and abstract, Applicant states "flowers" and "flower". Rather than stating "flowers" and "flower" applicant should state either

**Detailed Action**

--inflorescences-- or --inflorescence-- where appropriate as these are the more appropriate terms to use in these instances.

D. Page 2, line 8, and abstract, Applicant states leaf “peduncles”. Rather than stating “peduncles” applicant should state --petioles-- as this is the more appropriate term to use in this instance.

E. Page 3, line 7, Applicant should delete “leafcolour” and insert --leaf color--.

F. Page 3, lines 9-20, Applicants should set forth in the specification the age of the plant when described and container size, if grown in a container.

G. Page 4, lines 4-8, Applicant should set forth in the specification additional information relative to the instant plant including the typical and observed plant shape.

H. Page 4, line 6, Applicant states mature height is approximately 35 cm to “45 cm”. However, on page 2, line 5, and abstract, Applicant states mature height is approximately “40 cm”. These recitations are contradictory. Correction and/or clarification is necessary.

**Detailed Action**

I. Page 4, lines 10 and 11, Applicant should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed leaf margin descriptor.

J. Page 5, line 17 to page 6, line 1, Applicant should set forth in the specification additional information relative to the instant plant's petiole including the typical and observed petiole length.

K. Applicant should set forth in the specification the lastingness of the inflorescence, the recitation "unusual flower longevity" set forth on page 2, line 11, and abstract is meaningless.

L. Applicant should set forth in the specification information relative to the instant plant's scape including the typical and observed scape coloration with reference to the employed color chart.

M. Page 6, lines 4, 12-14, and 16, and abstract, Applicant states "peduncle". Rather than stating "peduncle", applicant should state --scape-- as this is the more appropriate term to use in this instance.

**Detailed Action**

N. Page 6, line 19 to page 7, line 2, Applicant should set forth in the specification additional information relative to the instant plant's spathe including the typical and observed spathe margin descriptor.

O. Page 7, lines 6-8, Applicant states "blossoms" and "flowers". Rather than stating "blossoms" and "flowers", applicant should state --inflorescences-- as this is the more appropriate term to use in these instances.

P. Page 7, line 19, Applicant states spadix turns "pink" then "green". Applicant should set forth in the specification a color designation for the "pink" and "green" colorations with reference to the employed color chart. The recitations "pink" and "green" are vague and insufficient in this regard.

Q. Page 7, lines 19 and 20, Applicant states the instant plant produces berries. Applicant should set forth in the specification information relative to the instant plant's berries including the typical and observed berry amount per spadix (if available), size, and coloration with reference to the employed color chart.

**Detailed Action**

R. Applicant should set forth in the specification the typical and observed number of flowers produced per spadix, flower shape, and diameter.

S. Page 1, line 8, Applicant should either underline or italicize “Anthurium” as this is the proper way to set forth a Genus followed by a species.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Detailed Action**

**Potential Issue Under 35 U.S.C. 102**

The claimed Anthurium variety ‘Anthbnem’ is described in Breeder’s Right application number 20011313 filed in The European Community on August 13, 2001 and published October 15, 2001. If the cultivar ‘Anthbnem’ was disclosed in the publication and on sale to the public more than one year prior to the effective filing date of the instant application, then the instant application may be a bar under 35 U.S.C. 102. The published application is a “printed publication” under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the European application, 20011313, are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication

**Detailed Action**

describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office’s collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office’s collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement

**Detailed Action**

for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

**Comments**

Applicant should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*

**Detailed Action**

**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, ‘Anthbnem’, was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide a copy of the published European Union application, 20011313. The Office does not maintain a collection of Breeders’ Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant’s first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

**Detailed Action**

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.